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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,984	01/13/2004	Garrett N. Ford	122142.00009	2249
57931	7590	09/06/2006		EXAMINER
ANTONIO R. DURANDO				NGUYEN, SONT
6902 N. TABLE MOUNTAIN ROAD			ART UNIT	PAPER NUMBER
TUCSON, AZ 85718-1331				3643

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/755,984
Filing Date: January 13, 2004
Appellant(s): FORD, GARRETT N.

Antonio Durando
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/19/06 appealing from the Office action
mailed 1/10/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adam (840892) in view of Nor (6062008).

Adam teaches an article of footwear for a hooved animal comprising a support 5,15; an enclosure 10 including a wall 10 on the support and a pair of tongues (at refs. 11 and 6) each of which is of one piece with the support and each of which has a major portion (the flaps) which is pivotable relative to the wall. In addition, Adam further teaches at least one band of elastic material 8,9 (inherently taught in Adam because most material such as one use for horse shoe straps are some what elastic so that a user can pull or adjust the straps around the horse hoof of varying sizes) connected to the tongue and the wall through cutouts 13; the tongue has a pair of opposed edges (left and right edges) and the at least one band 8 joins one of the edges to the wall, the enclosure including an additional band 9 joining the other of the edges to the wall; and the tongue and the band are made from different pieces of material (the tongue and band are separate elements made of separate pieces of material). Note that the claim

language of "different pieces of material" can be interpreted as different cut pieces of material and not necessary means the material has to be different. Note also that "elastic" is defined by the dictionary.com as flexible, thus, the straps 8,9 of Adam have some sort of flexibility to allow a user to adjust the straps to fit around different hooves since most straps employed in the art for horse boot are made some what flexible or elastic for adjustability.

However, in the event that it is not inherently taught in Adam that straps 8,9 are elastic, then Nor teaches the same field of endeavor of horse boot in which Nor employs attachment straps 16 made out of elastic webbing (col. 2, lines 25-27) to strap the horse boot around the horse's hoof. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the straps of Adam out of an elastic material as taught by Nor, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (allow for greater adjustability around a hoof) as a matter of obvious choice. *In re Leshin*, 125 USPQ 416.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

840892	ADAM	1-1907,
6062008	NOR	5-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adam (840892) in view of Nor (6062008).

(10) Response to Argument

Appellant argued that straps 8,9 of Adam are not elastic because elasticity is not an inherent property of straps, and usually it is an undesirable feature.

The Examiner believes that Adam's straps 8,9 are elastic some what because they are of known flexible straps to allow adjustability of the boot around various size hooves. From the drawings and specification of Adam, one of ordinary skill in the art would believe that those straps are some what elastic to wrap around the hooves. In addition, material such as straps used in the horse boot industry are some what elastic to accommodate different hoof sizes. In any event, if indeed that Appellant does not believe that straps in the art of horse boot are elastic, then the Examiner has relied on Nor for a teaching of an elastic strap 16 as stated in the above new grounds of rejection. Straps made out of an elastic material are so well known in the art of horse boot that it is definitely not an undesirable feature because the elasticity allows for adjustability of various hoof sizes because not all horses have same size hooves. Therefore, it would be unwise to make the straps inelastic, which means that only certain size hooves can be fitted. In addition, again, it is notoriously well known in the art that the straps for horse's boot are made elastic for comfort so that they hug on the hoof in a way that do not damage the hoof since it is elastic. So as one can see, it is not undesirable feature to have straps on horse boot made elastic as alleged by Appellant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,


Son T. Nguyen
Primary Examiner
AU 3643

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


APPROVED BY
DONALD T. HAILE
DIRECTOR, TECHNOLOGY CENTER 3600
Conferees:

Peter Poon 

Robert Swiatek 